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EXAMINER

GORDON, BRIAN R

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/509,147
Filing Date: May 25, 2000
Appellant(s): LADLOW ET AL.

Micheal Rechtin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 11, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

Appellant's brief presents arguments relating to the objection of claim 3 under 37 C.F.R. 1.75(c) and the amendment filed October 28, 2002 objected under 35 U.S.C. 132. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201.

The view of appellant's arguments directed to the objection of claim 3, the examiner hereby withdraws the objection.

Although appellant addresses the issue of the objection under 35 U.S.C. 132, it appears as if appellant's remark are related to the rejection of the material as rejected under 112, first paragraph (see page 6 of Final Office Action).

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(7) Grouping of Claims

The rejection of claims 1, 3-5, 7-9, and 11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 6, 10, and 12-20 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,594,129	Jones, A. R.	07-1971
3,356,346	Landsberger, K.	01-1966
WO 97/09353	Barker et al.	03-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "wherein the adapter block is structurally removable from the laboratory magnetic stirrer without removing a fastener" as recited in claim 1 is a limitation that is not recited and not adequately supported in the original specification. Appellant relies on the "Background of the Invention" as providing support for the limitation, however this portion of the specification is not considered be appellant's invention but that of prior art. There is also no recitation of the adapter block of the instant invention being removable without removing a fastener. The specification only recites that the adapter block is effectively positioned to effectively locate the reaction vessels for stirring. This does not provide adequate support for the recitation recited with the claims.

Claims 16, 18, and 20 also contain new matter that was not support by the original specification. The claims recite "a base portion of each vessel may be held substantially at the level of the recess", there is no specific recitation to such a characteristic of the base disclosed. There is also no mention of what level the vessels are held within the adapter block.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.
5. Claims 1 and 11 recite the limitation "a recess in the base" in line 2. There is insufficient antecedent basis for this limitation in the claim. The phrase "the base" should be "a base".
6. As to claim 3, the device of claim 1 cannot be limited by claim 3 because appellant defines the guide means on page 4, second paragraph, as comprising the central recess 5a that is formed by the rim 5b. How can the device of claim 1 be further limited as recited in claim 3, when the recess (which is the guide means) has already been claimed as an element of the invention.
7. As to claim 4, it is unclear because the sockets are the fixing means and as claimed it appears as if the sockets are an element of the fixing means.
8. As to claim 12, it is unclear how the magnetic stirrer further comprises a hotplate operatively connected to the magnetic stirrer. It appears as if appellant's intention is claim a combination of a magnetic stirrer comprising a hotplate and a condenser connected to the adapter block fitted on the magnetic stirrer.
9. As to claim 13, it is unclear how the magnetic stirrer further comprises a condenser unit. It appears as if appellant's intention is claim a combination of a magnetic stirrer a condenser connected to the adapter block fitted on the magnetic stirrer. The condenser unit is not an element of the stirrer but is actually a unit the may

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be optionally used in conjunction with appellant's block as recited on page 3 of the specification.

10. Claims 17 and 19 are redundant claims for the "holders" are equivalent to the "sockets" of claims 1 and 11.

11. Claims 11 and 13 recite the limitation "each and every socket". There is insufficient antecedent basis for this limitation in the claim. The examiner understands from page 4 of the specification that the fixing means is the sockets. It is suggested that appellant amend the claims to recite "fixing means in the form of a plurality of sockets for holding a plurality of reaction vessels....." in order to provide the antecedent basis.

12. Claim 14 recites the limitations "the base" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by A. R. Jones 3,594,129.

The analyzer of Jones comprises a turntable (adapter block) that has a series of openings (fixing means) 16 in a ring (guide means) 17 on its periphery for holding vessels 18. The turntable rotates above the platform which it is fitted via a recess (see

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figures). The vessels may be rotated to an appropriate position to allow the dispensing of a reagent into the vessel to allow for the observation of a reaction.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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18. Claims 1-5, 7-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsberger, US Patent 3,356,346 in view of A. R. Jones 3,594,129.

Landsberger discloses a test tube stirring block for use in combination with a stirring machine. The support block 10 is made of vinyl material which allows it to hold a plurality of test tubes 12 (of any size) in apertures 20 (sockets) located about the perimeter of the circular block 10. While the fluid is in the test tubes it is stirred by a stirring magnet 26 that is attracted and repelled by conventional means such as a magnetic stirring machine. As seen in Figure 1 the test tubes are automatically guided into the appropriate position for stirring as they are placed within the apertures.

Landsberger does not disclose that adapter block is chemical resistant and each vessel is located in a position around the periphery of the recess.

The analyzer of Jones comprises a turntable (adapter block) that has a series of openings (fixing means) 16 in a ring (guide means) 17 on its periphery for holding vessels 18. The turntable rotates above the platform which it is fitted via a recess (see figures). The vessels may be rotated to an appropriate position to allow the dispensing of a reagent into the vessel to allow for the observation of a reaction.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Landsberger by incorporating the teachings of Jones in order to allow the block (turntable) to have the vessels located outside the periphery of the recess in order to allow the block to rotate to a position to allow liquid to be dispensed in the vessels for mixing and observing the reactions.

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As to claim 7, it is obvious that all materials conduct heat to some extent. However, it is also well known in the art and conventional for magnetic stirrers to incorporate hotplates which conduct heat to the samples being stirred. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device by fabricating the block or holder of a conductive material to allow for simultaneous heating and stirring.

19. Claims 6, 10, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsberger, US Patent 3,356,346 in view of A. R. Jones 3,594,129 as applied to claims 1-5, 7-9 and 11 above, and further in view of Baker 97/09353.

The modified teachings of Landsberger in view of Jones do not disclose that the device incorporates a gas manifold/condenser.

Baker however discloses a synthesis block in which vessels may be placed and heated to the desired reaction temperature. The device comprises a temperature control block 18 (gas manifold) that incorporates a gas inlet for heating and cooling water inlet and outlet (condenser) to allow for the optimum heating and cooling of the chemical reagents in the vessels.

It would have been obvious to one of ordinary skill in the art to modify the modified hotplate stirrer of Landsberger in view of Jones by also incorporating the heating and cooling system of Baker to allow for optimum control of the heating and cooling of the reagents contained in the vessels of the block.

(11) Response to Argument

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Issue 1

Appellant asserts that the limitation of “the adapter block is structurally removable from the laboratory magnetic stirrer without removing a fastener” is supported by the figures. The examiner disagrees and furthermore, it has been held that a negative limitation not literally disclosed violates the *description* requirement and the negative limitation is considered new matter. *Ex parte Grassilli* 231 USPQ 393, 395. In view of such the 112, first paragraph, rejection is hereby maintained.

As to the limitation “a base portion of each vessel may be held substantially at the level of the recess” being supported by the figures, the examiner disagrees for it appears that in a resting position the base of the vessels would be located at a distance midway between the total depth of the recess (see figure 3). Furthermore, it is unclear what is meant by “the level”. Is appellant referring to the level at which the recess ends or begins? The neither specification nor figures clearly support this limitation.

Issue 2

Appellant argues on page 5 of the brief that the specification states that preferred fixing means are comprised of sockets and that appellant’s intent is not to limit the fixing means to just a plurality of sockets. Contrary to appellant’s assertion, the specification does not give any other form that may be included in the fixing means. Appellant further asserts that holders of claims 17 and 19 and the sockets of claims 1 and 11 are not equivalent. The term “sockets” as mentioned by appellant is recited on page 2 lines 9 and 10 as the preferable fixing means. The term “holders” has not been mentioned or defined in the specification. Appellant’s specification does not provide an adequate

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description to determine specifically what structures are considered "holders". As previously explained in the final office action on page 7, the examiner as considered the holders and sockets equivalent since the structure of the holders was not previously defined. Since the examiner considered the terms "sockets" and "holders" equivalents the claims are considered duplicates. Appellant only mentions sockets as a fixing means. Referring to the figures, it appears that the only fixing means are the sockets. Therefore, the inclusion of the term holders (as considered by appellant) would establish new matter being added to the application.

As to claims 12 and 13, as previously discussed, the condenser unit is not an element of the stirrer but is actually a unit the may be optionally used in conjunction with appellant's block as recited on page 3 of the specification. The condenser is in communication with the reaction vessels (not claimed as elements of the device) not the adapter block as explained on pager 3, lines 17-22 and page 4 of appellant's specification. The specification does not describe the condenser unit as being connected to the adapter block in a manner in which one would consider the condenser unit as an actual element of the magnetic stirrer. It appears as if the condenser is a separate device that may be used in a process along with the magnetic stirrer.

Issue 3

Appellant remarks on page 6 of the brief state that the 102 rejection of claim 1,3-5, and 18 as being anticipated by Jones is improper. Appellant states that apparatus of Jones is an analyzer that does not accommodate a plurality of reaction vessels so that the plurality of reaction vessels is positioned for stirring with respect to a magnetic field.

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This statement is directed to the intended use of each device not the structure of each device.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Appellant also states that Jones does not teach a “removable adapter block that is structurally distinct from the remainder of the laboratory unit”. The claims do recite a removable adapter block, but do not specifically use the phrase: “that is structurally distinct from the remainder of the laboratory unit”. The implications of the phrase are not considered an issue of the claim. Appellant also states that Jones does not teach “the “turntable” is intended to be easily removable without having to remove a fastener and can be adapted for use on multiple stirrup magnetic stirrers, as is specifically described in the present application”. Appellant’s arguments are based upon the intended use of the structure.

Appellant has clarified that the guide means is comprised of the recess and the rim. Appellant’s arguments on page 8 of the brief in relationship to the guide means are moreso geared to the intended use of the adapter block in use with a magnetic stirrer (process limitation) that does not structurally limit the device. It can be clearly seen in Figures 9-10 of the Jones reference that portion of the turntable that holds the reaction vessels comprises a recess with a rim that allows the upper portion of the turntable to fit over a second portion of the device (distinguished in the figures by means of diagonal lines extending upward as viewed from left to right).

Issue 4

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Appellant states that neither the Jones nor Landsberger disclose a device capable of accommodating a plurality of reaction vessels so that the plurality of reaction vessels is positioned for stirring with respect to a magnetic field, nor does the examiner demonstrate any motivation to combine the teachings of Landsberger and Jones. The examiner hereby asserts that the combined teachings of Landsberger and Jones do teach an apparatus as recited in the instant claims. While the motivation to combine the teachings of the two references may not be directed to solving situations or problems as mentioned by appellant on pages 9-10, the examiner asserts that the motivation for combining the teachings to modify the device of Landsberger by the teachings of Jones allows the block (turntable) to have the vessels located outside the periphery of the recess in order to allow the block to rotate to a position to allow liquid to be dispensed in the vessels for mixing and observing the reactions, is perfectly appropriate. Motivation to combine features does not need to be appellant's motivation.

As to the negative limitation of the claims (which has been addressed above as new matter) that states "without removing a fastener", the examiner asserts that while Jones employs a fastener to secure the turntable if one were not concerned with the security of the table, the fastener would not be employed allowing one to remove the turntable.

Appellant also went to the extent of explaining what problems, the invention of instant claims is intended to solve. The problems associated with the prior art are not issues of the structural limitations of the claims. For example, the ability of the device to ensuring that equal magnetic force is applied to the vessels is not mentioned in the

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claims. The claims (1, 11, and 13) recite, "the adapter block is positioned within the magnetic field generated by the magnetic stirrer such that each and every socket is effectively positioned for stirring with respect to the magnetic field." This is an intended use limitation of the adapter block and moreso a process limitation of how the adapter block may be use. Although the statement is considered as intended use, the examiner asserts that he modified device of Landsberger is capable of performing as such.

Issue 5

In reference to the 103 rejection of claims 6,10, and 12-20 over Landsberger in view of Jones and further in view of Baker, appellant has stated the examiner has failed to provide motivation to combine Baker with Landsberger and Jones. Appellant also states that the combined references do not teach a device capable of accommodating a plurality of reaction vessels so that the plurality of reaction vessels is positioned for stirring with respect to a magnetic field (previously mentioned and addressed in Issue 4). As to the motivation to combine the teachings of Baker with that of Landsberger and Jones, the examiner has previously stated that the incorporation of the heating and cooling system of Barker allows for optimum control of the heating and cooling of the reagents contained in the vessels of the block. Appellant further asserts that the combined references do not address the problem of uneven stirring. As previously stated, this problem is not an issue recited within claims and provides no structure to the instant invention.

Appellant also asserts that the references do not teach the base portion of each vessel may be held substantially at the level of the recess as recited in claims 18 and

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19. As previously stated, there is no explanation given with the specification for one to clearly interpret what is meant by located at substantially the level of the recess. This is also a process limitation directed to the location of the vessels during a method of using the device. The vessels are not elements of the invention and therefore the locations of the vessels are not an issue of the claimed invention. Furthermore, the phrase is a relative phrase that allows one to decide what is considered substantially at the level of the recess since no standard or numerical range has been given to determine what is an acceptable location in relationship to the recess. Is the level that appellant references the top or bottom level of the recess? Appellant states that Landsberger discloses vessels located above the magnetic rotor. The vessel location in reference to the rotor is not an issue of the claims. Although the vessels may be located above the magnetic rotor, when inserted in the sockets, they are at substantially the same level as the recess (see figure 4).

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



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brg
October 20, 2003

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